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09/990,888	11/09/2001	Katsuhiko Makino	020274-000100US	2247

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EXAMINER

JOHNSON, GREGORY L

ART UNIT	PAPER NUMBER
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3691

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/990,888	Applicant(s) MAKINO ET AL.	
	Examiner GREGORY JOHNSON	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-12 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8-12 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the Request for Continued Examination filed July 10, 2008.

Status of Claims

2. Claims 1, 8, 12 and 18 are amended. Claims 2-7, 13-17 and 24-26 are canceled. Claims 9-11 and 19-23 are original. Claims 1, 8-12 and 18-23 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8-12 and 18-23 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of Applicant's amendment to the claims 1, 8, 12 and 18, the rejections are withdrawn.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1, 8-12 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Melchione et al., Pat. No. 5,930,764 (hereinafter Melchione), in view of Zeanah et al., Pat. No. 5,933,816 (hereinafter Zeanah), Horowitz et al., Pat. No. 6,349,290 (hereinafter Horowitz), Kolls, Pat. No. 6,622,124 (hereinafter Kolls), Michelle Clayton, "New 'share of customer' innovations" (hereinafter Clayton) and John Mahnke, "Banking MIS challenged to develop next-generation self- service ATMs" (hereinafter Mahnke).

The rejections of claims 8 and 18 stand as set forth in the Office Action filed February 11, 2008. And the rejections of claims 9-11 and 19-23 stand as set forth in the Office Action filed July 26, 2007.

As to claim 1, Melchione discloses a method for reporting on a customer to an employee at the branch of a commercial establishment (e.g. tracking and reporting; col. 11, lines 50-58), the establishment having a central system and a branch system (Abstract and col. 9, lines 30-45), wherein the central system maintains customer

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service information pertaining to services offered by the establishment, and associated with the customer and that may be of interest to the customer (col. 6, lines 26-39; col. 7, lines 59-67; and col. 10, lines 8-33), and wherein the branch system has a self-service terminal for the customer to conduct transactions at the branch (col. 4, lines 17-29 and col. 35, lines 36-45), the method comprising:

- transferring customer service information from the central system to the branch system (col. 5, lines 43-57 and col. 11, line 59 thru col. 12, line 21);
- wherein the step of transferring customer service information from the central system to the branch system is performed periodically at one or more predetermined times during each day (col. 14, lines 36-46);
- wherein the commercial establishment is a bank and the customer service information pertains to financial services offered by the bank (col. 5, lines 33-57);
- wherein the self-service terminal is an automated teller machine (ATM) (col. 35, lines 36-45); and
- wherein the branch system further comprises a database for storing the customer service information from the central system, and a server for managing the database (e.g. workstation with database; col. 10, line 66 thru col. 11, line 27).

Melchione does not disclose the following limitations; however the limitations are taught by Zeanah:

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- generating customer-specific information (e.g. customer profile) at the self-service terminal when a customer initiates a transaction at the self-service terminal, said customer-specific information identifying the customer (e.g. authenticating; col. 11, line 28 thru col. 12, line 12); and
- wherein the customer service information is updated at the branch system and provided to the central system after the employee provides personal attention to the customer (col. 32, lines 32-58 and col. 33, lines 16-19), the updated customer service information reflecting the status of any current transaction by the customer at the self-service terminal (e.g. update account information; col. 17, lines 19-35); and
- wherein the ATM displays the customer service information to the customer when conducting a transaction at the ATM (Abstract; col. 5, lines 39-60).

Melchione discloses a sales process to improve marketing success of financial services for use by financial institutions. Melchione discloses that the process includes receiving comprehensive information from a variety of internal and external feeds (e.g. ATM). Melchione also discloses the electronic distribution of sales leads to branch offices (Abstract). And Zeanah teaches a system and method for delivering financial services to automatic teller machines and internally within financial institutions to staff terminals and to the individual branches of the financial institutions (Abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the sales support and marketing system as disclosed by Melchione, the

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method of delivering financial services as taught by Zeanah, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable.

See MPEP 2143 (Rev. 6, Sept. 2007).

Melchione also does not disclose the following limitations; however the limitations are taught by Horowitz:

- transmitting a report on the customer from the branch system in response to the generation of customer-specific information at the self-service terminal, the report identifying the customer and the customer service information (e.g. token data; col. 1, line 65 thru col. 2, line 4; col. 3, lines 52-58; col. 3, line 58 thru col. 4, line 67);
- wherein the report is provided to the branch employee (e.g. customer service representative “CSR”), for use in providing personal attention to the customer in connection with the customer service information (col. 18, lines 58-63); and
- the updated customer service information reflecting the reaction of the customer to the personal attention with the customer service information (e.g. updating customer profile based on customer’s reaction to the advice on financial products and/or services; col. 4, lines 59-67 and col. 5, lines 21-47).

Melchione discloses a sales process to improve marketing success of financial services for use by financial institutions. Melchione discloses that the process includes receiving comprehensive information from a variety of internal and external feeds (e.g. ATM). Melchione also discloses the electronic distribution of sales leads to branch offices (Abstract). And Horowitz teaches a system and method for customizing and personalizing the presentation of financial products and services of a financial institution (Abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the sales support and marketing system as disclosed by Melchione, the method of customizing and personalizing the presentation of financial products and services as taught by Horowitz, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Melchione also does not disclose the following limitations:

- that the report identifying the customer and the customer service information is used by the branch employee to promote services to the customer on-site at the branch; and
- a server for receiving customer-specific information from the self-service terminal when the customer initiates a transaction at the self-service terminal, the server causing the report to be transmitted in response to the customer specific information.

However, Clayton teaches a method for banks to maintain its deposit base and customers (Abstract). Clayton teaches the use of a system by NCR (AutoBank) that recording customer information in a Relational Database Management System (RDBMS). The recording of each customer transaction allows banks the ability to pinpoint which services customers are using and other services that might better suit the banks' or customer's needs. Clayton also teaches that the information contained in the RDBMS is sent to tellers (e.g. branch offices where tellers historically deliver in-person assistance) and customer service representatives in order to sell new loans and suggest new products (see page 4-5). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the sales support and marketing system as disclosed by Melchione, the recording and distributing of customer information to bank personnel as taught by Clayton, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Melchione also does not disclose the following limitation:

- that the personal attention provided is in-person at the branch by the branch employee to the customer.

However, Mahnke teaches MIS departments in banks are being challenged to develop and support next generation self-service technology (see page 1). Mahnke also teaches that with an integrated LAN, a salesperson could be informed that a customer

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is using an interactive customer service machine and that the salesperson could then go over to the customer and provide (in-person) assistance. It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the system and method for delivering financial services of Zeanah, the method of providing customer assistance as taught by Mahnke since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

As to claim 12, Melchione discloses a bank network, comprising:

- a central system that collects and stores customer attribute information and customer service information, the customer attribute information pertaining to personal information of a customer, and the customer service information pertaining to services offered by the bank and associated with the customer, and that may be of interest to the customer; (col. 6, lines 26-39; col. 7, line 41 thru col. 8, line 7; and col. 10, lines 8-33);
- a branch system, including one or more automated teller machines (ATMs) located at a branch office of the bank, the branch system receiving the personal attribute information and the customer service information from the central system (col. 5, lines 43-57; col. 10, line 66 thru col. 11, line 27; col. 11, line 59 thru col. 12, line 21; and col. 35, lines 36-45).

Melchione does not disclose the following limitation; however the limitation is taught by Zeanah:

- transferring the customer service information to the ATM for display when the customer conducts a transaction at the ATM (Abstract; col. 5, lines 39-60).

Melchione discloses a sales process to improve marketing success of financial services for use by financial institutions. Melchione discloses that the process includes receiving comprehensive information from a variety of internal and external feeds (e.g. ATM). Melchione also discloses the electronic distribution of sales leads to branch offices (Abstract). And Zeanah teaches a system and method for delivering financial services to automatic teller machines and internally within financial institutions to staff terminals and to the individual branches of the financial institutions (Abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include in the sales support and marketing system as disclosed by Melchione, the method of delivering financial services as taught by Zeanah, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

Melchione also does not disclose the following limitations:

- a terminal for receiving a report from the branch system when the customer conducts a transaction at the ATM, the report identifying the customer and the customer service information; and
- wherein the report received at the terminal is provided to a bank representative at the branch office, for use by the bank representative in providing personal, in-person attention to the customer at the branch office in connection with the customer service information.

However, Clayton teaches a method for banks to maintain its deposit base and customers (Abstract). Clayton teaches the use of a system by NCR (AutoBank) that recording customer information in a Relational Database Management System (RDBMS). The recording of each customer transaction allows banks the ability to pinpoint which services customers are using and other services that might better suit the banks' or customer's needs. Clayton also teaches that the information contained in the RDBMS is sent to tellers (e.g. branch offices where tellers historically deliver in-person assistance) and customer service representatives in order to sell new loans and suggest new products (see page 4-5). It would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to include in the sales support and marketing system as disclosed by Melchione, the recording and distributing of customer information to bank personnel as taught by Clayton, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in

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that art would have recognized that the results of the combination were predictable. See MPEP 2143 (Rev. 6, Sept. 2007).

The remaining limitations of Claim 12 are equivalent to the limitations recited in Claim 1, and are therefore rejected on the same grounds.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 8-12 and 18-23 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON
Examiner, Art Unit 3691